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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/568,131
Filing Date: July 21, 2006
Appellant(s): PRICE ET AL.

Scott Smith
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 6/17/08 appealing from the Office action mailed 10/19/07.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. Claims 7-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carmody (3,687,136) in view of Dow (5,120,325).

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

2905174	Smith	9-1959
3687136	Carmody	8-1972
5120325	Dow, Jr.	6-1992

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carmody (3,687,136) in view of Dow (5,120,325) and Smith (2,905,174).

As regards claim 1, Carmody disclose a bandage for cosmetic use, thereby being a cosmetic bandage. The bandage comprises a transparent backing (10), a pressure sensitive adhesive (12), a pad (16) and a pigmented plastic strip, which lies on top of the pad.

Carmody fails to teach that the adhesive is transparent and that the pigment is non-toxic. As to the transparent adhesive, Smith teaches it is conventional in the art to provide adhesive bandages having pigment therein with transparent adhesive for the inherent purpose of being invisible to the eye so render the bandage inconspicuous.

In view of Smith, it would have been obvious to one having ordinary skill in the art to use a transparent pressure sensitive adhesive for the purpose of rendering the adhesive invisible to the eye so render the bandage inconspicuous.

As to the non-toxic pigment, Dow, Jr. discloses a color matched adhesive bandage comprising a non-toxic pigment to inherently ensure that the user is not poisoned by the pigment.

In view of Carmody, it would have been further obvious to substitute the colored plastic strip (14) of Carmody for the non-toxic pigment of Dow, Jr. to insure that the user is not poisoned by the pigment.

As regards claim 2, note the disclosure of the use of pressure sensitive adhesive at col. 2, line 9 of Carmody.

As regards claim 3, note removable strips (18) of Carmody.

As regards claim 4, Carmody fails to teach a plurality of pigments are blended to match the skin. However, Dow, Jr. at col. 3, lines 63-66 discloses the use of a plurality of colors (pigments) in order to achieve the desired color to match the skin. In view of Dow, Jr., it would have been obvious to one having ordinary skill in the art at the time the invention was made to blend a plurality of

colors (pigments) to achieve the desired color of the colored strip (14) of Carmody in order to match the skin.

As regards claim 5, Carmody fails to teach that the color is embedded in the pad: Absent a critical teaching and/or showing of unexpected results derived from use of embedded the pigment in the pad, the examiner contends that any means for providing color to the bandage of Carmody to achieve the desired result of matching the bandage to the skin is an obvious design choice which does not distinguish appellant's invention.

Regarding claim 6, as can be seen from Figs. 2 and 4, when the components of the bandage are joined together, pigmented (colored) strip (14) lays on (coated on) the top of the pad.

Claims 7-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carmody (3,687,136) in view of Dow (5,120,325).

As regards claim 7, Carmody discloses a bandage and inherently discloses the claimed method of constructing the bandage. As can be seen from Fig. 4 and as can be read from col. 2, Carmody discloses applying a pigment in the form of a colored plastic strip (14) to a transparent backing (10). Carmody fails to teach that the pigment is a non-toxic pigment. However, Dow, Jr. discloses a color matched adhesive bandage comprising a non-toxic pigment to inherently insure that the user is not poisoned by the pigment.

In view of Carmody, it would have been obvious to substitute the colored plastic strip (14) of Carmody for the non-toxic pigment of Dow, Jr. to ensure that the user is not poisoned by the pigment.

As regards claim 8, the adhesive must be applied to the backing before attaching pad (16) in order that pad (1.6) remains adhered to the backing.

As regards claim 9, note removable strips (18).

As regards claims 10 and 11, the steps of applying the pigment to the pad by a silk screening process or a flood printing process is neither disclosed nor taught by Carmody. Absent a critical teaching and/or a showing of unexpected results derived from applying the pigment to the pad by a silk screening process or a flood printing process, the examiner concludes that the process by which the pigment (color) is added to the pad is an obvious design choice, which does not distinguish appellant's invention.

(10) Response to Arguments

Appellant's arguments filed in the appeal brief of 6/17/08 have been fully considered but they are not persuasive.

Appellant argues the following: 1) that the examiner has disregarded the "subject matter as a whole" language of the 35 USC 103(a) statute, and has apparently used Appellant's specification as a guide to improperly construct the rejection element by element. Also argued is that the examiner does not detail why one of ordinary skill in the art would have combined the references in the manner claimed; 2) that none of the

cited references disclose "an absorbent pad having a bottom side and a top side, the top side having a non-toxic pigmented composition applied to it" or the step of "applying a non-toxic pigment to the top side of the pad"; 3) that nothing in the cited references discloses or suggest the equivalency of a pigmented plastic strip with a pigmented composition applied to the pad; and 4) that neither Smith nor Dow suggest or disclose a pad with applied pigment or the step of applying pigment to the pad. Appellant further contends that without providing proper rationale, the Examiner concludes that it would have been obvious to one of ordinary skill in the art at the time the invention was made, to form the bandage of Carmody with a transparent pressure sensitive adhesive as taught by Dow. Appellant also concludes that Smith teaches away from such a combination by disclosing the use of a transparent backing, and further that the Examiner fails to establish a *prima facie* case of obviousness.

In each argued instance the examiner disagrees. The examiner has not disregarded "the subject matter as a whole" language of the 35 USC 103(a) statute. In fact, the examiner has relied on "the subject matter as a whole" and has concluded that the invention is unpatentable over Carmody in view of Dow and Smith.

Carmody, Dow and Smith are related in that their purpose is to provide bandages that closely match the color of the user's skin so as to render the bandage inconspicuous when applied. Carmody uses a pigmented plastic strip applied to the top surface of a pad to match skin tone. Dow uses a non-toxic pigmented composition coated onto or embedded in the top surface of the backing, and Smith uses flesh colored markings applied to the backing.

As outlined in the rejection above, Carmody discloses all features of the claim except that the adhesive is transparent and that the pigment is non-toxic. The examiner relies on Smith for teaching a transparent adhesive and Dow for teaching a non-toxic pigment. The examiner further provides **proper rationale** in both the rejection, as well as in the response to the arguments in the office action of 10/19/07. With respect to Smith, the examiner concluded that it would have been obvious to one having ordinary skill in the art to use a transparent pressure sensitive adhesive for the purpose of rendering the adhesive invisible to the eye so render the bandage inconspicuous. With respect to Dow, the examiner concluded that it would have been further obvious to substitute the colored plastic strip (14) of Carmody for the non-toxic pigment of Dow, Jr. to ensure that the user is not poisoned by the pigment.

As to the equivalency of the pigmented plastic and the pigmented composition, there was evidence at the time of invention that both the pigmented plastic strip (used in Carmody) and the non-toxic pigment composition (used in Dow) were known compositions used in the bandage art to render bandages inconspicuous on a user. Appellant should note that an express suggestion to substitute one equivalent component or process for another is not necessary to render such substitution obvious. *In re Fout*, 675, F.2d, 297, 213 USPQ 532 (CCPA 1982). This, in the examiner's opinion represents evidence of obviousness in substituting one pigmented composition for another.

Furthermore, Appellant should note that after the examiner has made the *prima facie* case of equivalence, **appellant bears the burden of proving nonequivalence**.

At present, Appellant has not proven nonequivalence of the pigmented plastic strip and the pigmented composition.

In conclusion, the examiner contends that since Smith is relied upon only for teaching a transparent adhesive, it does not teach away from the instant invention, and since Dow was relied upon for teaching a non-toxic pigmented composition capable of being substituted for the pigmented strip of Carmody, all of limitations are expressly disclosed in Carmody or made obvious by Smith and Dow. Thus, the examiner has established a *prima facie* case of obviousness.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Kim M. Lewis/, Primary Examiner AU 3772

Conferees:

Patricia Bianco, Supervisory Patent Examiner, AU 3772

/Patricia Bianco/

Supervisory Patent Examiner, Art Unit 3772

Thomas Barrett, Quality Assurance Specialist TC3700

/Thomas Barrett/